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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Thomas Odorzynski Art Unit: 3622
Serial No. 10/748,715
Filed December 30, 2003
Confirmation No.: 2119
For: SELLING AD SPACE ON DIAPERS
Examiner James W. Myhre

October 7, 2008

AMENDMENT C AND RESPONSE AFTER RCE

TO THE ASSISTANT COMMISSIONER FOR PATENTS,
SIR/MADAM:

This Amendment C and Response After RCE is submitted in response to the final Office action mailed August 19, 2008. Please consider the amendments and remarks made herein.

Amendments to the Claims are shown in the Listing of Claims which begins on page 2 of this paper.

Remarks begin on page 9 of this paper.

Conclusion is on page 21 of this paper.

Listing of Claims:

1. (Previously Presented) A method of advertising, the method comprising:

selling space on a disposable diaper to a sponsor; and
placing an ad for a product other than disposable diapers onto the disposable diaper.

2. (Cancelled).

3. (Previously Presented) The method of claim 1 further comprising selling the disposable diaper to customers.

4. (Previously Presented) The method of claim 1 wherein the ad is a first ad, the product is a first product and the sponsor is a first sponsor, and wherein the method further comprises:

selling space on the disposable diaper to a second sponsor;
and

placing a second ad for a second product other than disposable diapers onto the disposable diaper.

5. (Previously Presented) The method of claim 4 wherein placing the first ad onto the disposable diaper includes placing the first ad on a front of the disposable diaper, and placing the second ad onto the disposable diaper includes placing the second ad on a back of the disposable diaper.

6. (Previously Presented) The method of claim 1 wherein placing the ad onto the disposable diaper includes printing the ad onto the disposable diaper.

7. (Previously Presented) The method of claim 1 wherein placing the ad onto the disposable diaper includes affixing a detachable ad onto the disposable diaper.

8. (Previously Presented) A system for generating advertising revenue comprising:

a disposable diaper; and

an ad for products other than disposable diapers placed onto the disposable diaper.

9. (Cancelled).

10. (Previously Presented) The system of claim 8 wherein the disposable diaper includes a first ad on a front of the disposable diaper and a second ad on a back of the disposable diaper.

11. (Previously Presented) The system of claim 10 wherein the first ad is for a first product other than disposable diapers and the second ad is for a second product other than disposable diapers.

12. (Previously Presented) The system of claim 8 wherein the ad is printed onto the disposable diaper.

13. (Previously Presented) The system of claim 8 wherein the ad is detachable from the disposable diaper.

14. (Previously Presented) A method of promoting product purchases, the method comprising:

placing a promotion relating to purchasing the product onto a disposable diaper; and

selling the disposable diaper to a customer.

15. (Previously Presented) The method of claim 14 further comprising manufacturing the disposable diaper.

16. (Previously Presented) The method of claim 14 wherein placing a promotion onto the disposable diaper includes placing a promotion relating to purchasing disposable diapers onto the disposable diaper.

17. (Previously Presented) The method of claim 14 wherein placing a promotion onto the disposable diaper includes placing a promotion relating to purchasing a product other than disposable diapers onto the disposable diaper.

18. (Previously Presented) The method of claim 14 wherein placing a promotion onto the disposable diaper includes placing a coupon for purchasing the product onto the disposable diaper.

19. (Cancelled).

20. (Previously Presented) The method of claim 14 wherein placing a promotion onto the disposable diaper includes selling

space on the disposable diaper to a sponsor to place the promotion onto the disposable diaper.

21. (Cancelled).

22. (Previously Presented) A system for promoting product purchases, the system comprising:

a disposable diaper; and

a promotion related to purchasing the product, the promotion being placed onto the disposable diaper.

23. (Cancelled).

24. (Previously Presented) The system of claim 22 wherein the disposable diaper includes a first promotion on a front of the disposable diaper and a second promotion on a back of the disposable diaper.

25. (Previously Presented) The system of claim 22 wherein the promotion relates to purchasing disposable diapers.

26. (Previously Presented) The system of claim 22 wherein the promotion relates to purchasing products other than disposable diapers.

27. (Previously Presented) The system of claim 22 wherein the disposable diaper includes a first promotion that is related to purchasing a product other than disposable diapers and a second promotion that is related to purchasing disposable diapers.

28. (Previously Presented) The system of claim 22 wherein the promotion is printed onto the disposable diaper.

29. (Previously Presented) The system of claim 22 wherein the promotion is detachable from the disposable diaper.

30. (Cancelled).

31. (Previously Presented) The method of claim 14 wherein the promotion is in the form of a code that the consumer provides to a retailer of the product to obtain a purchasing benefit.

32.(Previously Presented) The system of claim 22 wherein the promotion is in the form of a code that the consumer provides to a retailer of the product to obtain a purchasing benefit.

33. (New) A method of advertising, the method comprising:
providing a disposable diaper, the diaper comprising: an absorbent pad, a bodyside liner, and a liquid impermeable backsheet;

selling space on a disposable diaper to a sponsor; and
placing an ad for a product other than disposable diapers onto the disposable diaper.

REMARKS

Claims 1, 3-8, 10-18, 20, 22, 24-29, and 31-33 will be pending upon entry of this Amendment C and Response After RCE. Claim 33 has been added. Support for new claim 33 can be found throughout the specification as the instant application is directed to advertising on disposable diapers, and further, as well known in the art, and specifically mentioned in U.S. Patent Nos. 4,213,459; 6,162,961; 6,659,990; and 7,294,593, disposable diapers include an absorbent layer, and a bodyside liner, and a breathable film outerlayer. Applicant respectfully requests reconsideration and allowance of all pending claims.

1. Objection to Claims

The Office has stated that claims 20, 22, 24, and 27-29 will be objected to under 37 CFR 1.75 as being substantial duplicates of claims 3, 8, and 10-13, respectively, if the latter claims are found allowable. Applicant wishes to address this potential objection at a later time, specifically, when claims 3, 8, and 10-13 have been found allowable. If the Office has any questions or concerns, please contact Applicant's representative, Mr. Christopher M. Goff, at 314-621-5070.

2. Rejection of Claims 1, 3, 6, 8, 12, 14-17, 20, 22, 25, 26, and 28 Under 35 U.S.C. §102(b)

Reconsideration is requested of the rejection of claims 1, 3, 6, 8, 12, 14-17, 20, 22, 25, 26, 28, 31, and 32 under 35 U.S.C. §102(b) as being anticipated by Gabler (U.S. 5,481,758)

Claim 1 is directed to a method of advertising. The method comprises: selling space on a **disposable diaper** to a sponsor; and placing an ad for a product other than disposable diapers **onto the disposable diaper**.

Claim 8 is directed to a system for generating advertising revenue comprising: a **disposable diaper**; and an ad for products other than disposable diapers placed **onto the disposable diaper**.

Claim 14 is directed to a method of promoting product purchases. The method comprises: placing a promotion relating to purchasing the product **onto a disposable diaper**; and selling the disposable diaper to a customer.

Claim 22 is directed to a system for promoting product purchases. The system comprises: a **disposable diaper**; and a promotion related to purchasing the products. The promotion is placed **on the disposable diaper**.

Gabler discloses a garment which carries a message in combination with a three-dimensional structure. More particularly, Gabler discloses an article of clothing having a reproduction of paper money, which appears to be protruding from the garment, to attract the attention of a viewer, and a message to be read by the viewer in close proximity to the paper money reproduction. The articles of clothing useful in Gabler can be outer garments intended to be seen on the wearer in public, such as pocket tee shirts, button shirts, jackets, vests, pants, shorts, and jeans, as well as articles of clothing only normally seen in private, such as novelty children's sleep wear, novelty underwear such as bras, panties, boxer shorts, and night gowns.

Significantly, Gabler fails to disclose applying the paper money reproduction (or any other design or graphic) on a

disposable diaper as required in Applicant's claimed invention. This is an important limitation of Applicant's claims 1, 8, 14, and 22, and a significant aspect of Applicant's claimed invention.

The Office apparently includes diaper with the articles of clothing and garments as disclosed in Gabler. Applicant respectfully disagrees with the Office as a disposable diaper, as required in Applicant's claimed invention, is not the same as an article of clothing such as a pocket tee shirt or underwear. Specifically, as well known in the art, disposable diapers typically include an absorbent pad, a bodyside liner material/liquid pervious topsheet, and a liquid impervious barrier layer/backsheets. (See, e.g., U.S. Patent Nos. 4,213,459; 6,162,961; 6,659,990; and 7,294,593). The backsheets or liquid impervious barrier layer, which is the material to which the ad or promotion will be attached, is conventionally made of a breathable film material, and in many embodiments, will have micropores to allow for improved breathability (see, U.S. Patent No. 6,659,990). As such, the outer material of the disposable diaper will have specific characteristics that the system and user of the system must keep in mind and recognize prior to placing the ad or promotion onto the disposable diaper. Specifically, the method of adhering and/or attaching the ad or promotion to the disposable diaper in such a manner as to remain on the diaper for a sufficient time must be kept in mind. Articles of clothing or garments such as the pocket tee shirt of Gabler are not made of breathable films and, thus, the above-mentioned considerations need not be designed around.

In the Response to Arguments section of the final Office action dated August 19, 2008, the Office argues that there is little, if any, patentable weight given to the type of clothing onto which the advertisements that are applied as Gabler explicitly discloses that the clothing can be children's underwear and diapers and disposable diapers are children underwear. Furthermore, the Office states that Applicant's argument that a disposable diaper is different because it includes such features as absorbent pads, bodyside liner, liquid pervious topsheet, liquid impervious backsheet, etc. is not persuasive as it is noted that the Applicant is arguing limitations not presently in the claims.

Applicants' again assert that no where in Gabler is it disclosed or taught to place an ad or promotion onto a **disposable diaper**. Gabler do disclose children's novelty underwear, however, Gabler explicitly lists bras, panties, boxer shorts, and night gowns. **No where** is there any teaching of **disposable diapers** being included in children's underwear.

With respect to relying on limitations not found in the claims, Applicants also respectfully disagree. Specifically, as noted in MPEP 2106, claims are not to be evaluated in a vacuum. As further stated in MPEP 2111.01, during examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. More particularly, "if elements of an

invention are well known in the art, the applicant does not have to provide a disclosure that describes those elements."¹

As well known in the art, "[m]odern disposable baby diapers and incontinence products have a layered construction, which allows the transfer and distribution of urine to an absorbent core structure where it is locked in. Basic layers are an **outer shell of breathable polyethylene film or a nonwoven and film composite** which prevents wetness and soil transfer, an **inner absorbent layer** of a mixture of cellulose pulp and superabsorbent polymers for wetness, and a **layer nearest the skin of nonwoven material** with a distribution layer directly beneath which transfers wetness to the absorbent layer."

(Definition of disposable diaper from Wikipedia, available on-line at <http://en.wikipedia.org/wiki/Diaper>; see also, "How Products are Made," volume 3, available on-line at <http://www.madehow.com/Volume-3/Disposable-Diaper.html>; U.S. Patent Nos. 4,213,459; 6,162,961; 6,659,990; and 7,294,593).

As the limitations of absorbent pads, bodyside liner, liquid pervious topsheet, liquid impervious backsheet are known in the art as being included in an article labeled with the term "disposable diaper," these limitations must be considered when considering the patentability of the instant claims. As noted above, no where in Gabler are these materials even mentioned for use in the articles to which messages can be applied.

The Office further states that how the article of clothing is made or what types of material it is composed of does not affect the steps of attaching one or more ads or promotions to

¹ M.P.E.P. § 2106.

the article. Applicants respectfully disagree as, noted above, the means for attachment is not necessarily the same for a cotton garment such as the pocket tee or underwear of Gabler as compared to the impervious backsheet or film of a disposable diaper as required in Applicants' claimed invention.

Specifically, as known in the art, many hot melt adhesives and other specific adhering materials are necessary for adhering components of a diaper together (see, e.g., U.S. Pat. Nos. 6,657,009; Re39,307; 6,872,784; and 7,241,493), and thus would also be needed for attaching the ad or promotion to the outer layer of the disposable diaper of Applicants' claimed invention.

Further, regarding applicant's argument that a disposable diaper is not disclosed in Gabler because of the features included in a disposable diaper, the Office asserts at page 7 of the instant office action that "many other articles of clothing also include one or more of these features, such as rainwear which includes liquid pervious and impervious layers to prevent the wearer from getting wet." Applicants respectfully submit that no where in Gabler is rainwear even mentioned, much less rainwear with Gabler's advertisement. Particularly, Gabler discloses only clothing articles including pocket tee shirts, button shirts, jackets which can be both casual jackets for personal wear and uniform jackets, vests, pants, shorts, particular jeans, novelty children's sleep wear, and novelty underwear such as bras, panties, boxer shorts, and night gowns. As such, one skilled in the art could not be motivated by Gabler to arrive at applicant's claimed invention through a disclosure of rainwear with an advertisement as Gabler does not even mention rainwear anywhere in its disclosure.

Based on the foregoing, Gabler simply fails to disclose a method or system of placing an ad or promotion onto a disposable diaper as required in Applicant's claims 1, 8, 14, and 22.

As stated in M.P.E.P. §2131, a claim is anticipated by a reference only if each and every element as set forth in the claim is found, either expressly or inherently described, in the cited reference. As noted above, Gabler fails to disclose each and every limitation of Applicant's claimed invention as Gabler fails to disclose or suggest placing an ad or promotion **onto a disposable diaper**. As such, claims 1, 8, 14, and 22 are novel over the Gabler reference.

Claims 3 and 6 depend directly or indirectly from claim 1, and thus are novel over the Gabler reference for the same reasons as claim 1 set forth above, as well as for the additional elements they require.

Claim 12 depends directly from claim 8, and thus are novel over the Gabler reference for the same reasons as claim 8 set forth above, as well as for the additional elements they require.

Claims 15-17, 20, and 31 depend directly from claim 14, and thus are novel over the Gable reference for the same reasons as claim 14 set forth above, as well as for the additional elements they require.

Claims 25, 26, 28, and 32 depend directly from claim 22, and thus are novel over the Gable reference for the same reasons as claim 22 set forth above, as well as for the additional elements they require.

In addition, claims 31 and 32 further require the promotion to be in the form of a code that the consumer provides to a retailer of the product to obtain a purchasing benefit.

The Office asserts at page 5 of the instant Office Action that "Gabler teaches the further limitation that the promotion is in the form of a 'code' as noted for claims 14 and 22, because the broadest reasonable interpretation of 'code' is any writing." Specifically, the Office asserts that because no specific definition of the term "code" is provided within the specification, that the term should be interpreted so broadly as to include "any writing." Applicants respectfully disagree.

M.P.E.P. §2111.01, citing *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, states that "[d]uring examination, the claims must be interpreted as broadly as their terms reasonably allow." (Emphasis added). This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321. Further, the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." (Emphasis added). *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313.

Applicants respectfully submit that the Office has interpreted the term "code" in a manner that is inconsistent with that of its plain or ordinary and customary meaning. Specifically, Wikipedia explains that in communications, a code is a rule for converting a piece of information into another

form or representation.² Wikipedia further explains that, specifically to coupon codes, "in marketing, coupon codes can be used for a financial discount or rebate when purchasing a product from an internet retailer." Moreover, the term "code" is defined by Merriam-Webster's Online Dictionary as "a system of signals or symbols for communication" or as "a system of symbols (as letters or numbers) used to represent assigned and often secret meanings." Applicants submit that in light of these well-known definitions, and when used in the context of a promotion on a product, one skilled in the art would not construe "code" as any writing, but rather would construe "code" to mean a system of symbols that represent a meaning other than what is plainly presented. Although Gabler teaches a garment which carries a message, each message exemplified in Gabler is written in sentence form and openly expresses the message it is to convey. As such, there is no teaching or suggestion in Gabler of a promotion that is in the form of a code as is required by claims 31 and 32. Accordingly, claims 31 and 32 are patentable for this additional reason.

New claim 33 is similar to claim 1 and further requires the step of providing a disposable diaper, the diaper comprising an **absorbent pad, a bodyside liner, and a liquid impervious backsheet**. Thus, claim 33 is patentable over the Gabler reference for the reasons as set forth above for claim 1, as well as for the additional limitations it requires.

²<http://en.eikipedia.org/wiki/Code>

3. Rejection of Claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 Under 35 U.S.C. §103(a)

Reconsideration is requested of the rejection of claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 under 35 U.S.C. §103(a) as being unpatentable over Gabler in view of Iwamoto (WO 03/02496).

Claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 depend from claims 1, 8, 14, and 22, respectively, which are discussed above. Claims 1, 8, 14, and 22 are patentable over the Gabler reference for the reasons set forth above; that is, Gabler fails to teach or suggest placing an ad or promotion **onto a disposable diaper**. Iwamoto fails to overcome this shortcoming.

Specifically, Iwamoto discloses a jacket having two chest pockets, wherein the pockets have an advertisement displayed thereon. The back body of the jacket may also have an advertisement display portion, displaying a commodity, an event or the like. The advertisement(s) may be printed or embroidered directly on the jacket. Alternatively, the advertisement may be detachable from the jacket. Similar, to Gabler, Iwamoto fails to teach or suggest placing an ad or promotion **onto a disposable diaper**.

Particularly, in order for the Office to show a *prima facie* case of obviousness, M.P.E.P. §2142 requires a clear articulation of the reasons why the claimed invention would have been obvious. Specifically, the Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the burden lies initially with the Office to provide an explicit analysis supporting a rejection under 35 U.S.C. 103. "[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must

be some **articulated reasoning** with some **rational underpinning** to support the legal conclusion of obviousness." The Court in KSR International further identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Specifically, as previously required by the TSM (teaching, suggestion, motivation) approach to obviousness, one exemplary rationale indicated requires some teaching, suggestion, or motivation in the prior art reference that would have led one of ordinary skill to modify the prior art reference to arrive at the claimed invention. Specifically, to reject a claim based on this rationale, the Office must articulate the following: (1) a finding that there was some teaching, suggestion, or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to arrive at each and every limitation of the claimed invention; (2) a finding that there was reasonable expectation of success; and (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. The Office has failed to meet its burden under number (1) above, as the cited references fail to show each and every limitation of Applicants' invention and there is no apparent reason for one skilled in the art to modify/combine reference teachings to arrive at each and every limitation. It simply would not have been obvious to one

skilled in the art to arrive at Applicants' claimed combinations.

Specifically, as noted above, neither cited reference teaches or suggests the method of placing an ad or promotion onto a disposable diaper. At best, the references teach placing an ad on an article of clothing such as a pocket tee shirt or jacket. No where, however, is a disposable diaper having the features (e.g., breathable film material and/or micropores) as well known in the art even mentioned. Furthermore, no where in the cited references is the recognition of designing the placement of the ad or promotion onto a breathable film material such as used on the outer layer of disposable diapers even mentioned. As such, there is simply no reason to modify the Gabler and Iwamoto references to arrive at each and every limitation of Applicant's claimed invention.

Moreover, the common sense of one ordinarily skilled in the art would not have provided a reason to modify the cited references to arrive at Applicant's disposable diaper with an ad and/or promotion placed thereon as required in claims 1, 8, 14, and 22. Specifically, as noted above, disposable diapers include materials such as breathable film materials and/or micropores that are not used in articles of clothing and, as such, why would one skilled in the art be motivated to place their ad or promotion, used on a tee shirt or jacket, onto a disposable diaper? It appears that the Office has merely used hindsight reasoning in combining these references, which has been specifically instructed against by the Federal Circuit. Based on the teachings of the cited references, there is simply

no motivation to modify the cited references to arrive at Applicant's instant claims 1, 8, 14, and 22.

As the cited references fail to disclose each and every limitation of Applicant's claims 1, 8, 14, and 22 and, further, there is no motivation or suggestion to modify the references to arrive at each and every limitation of Applicant's claims, claims 1, 8, 14, and 22 are patentable over Gabler in view of Iwamoto.

Furthermore, as claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 depend directly or indirectly on claims 1, 8, 14, and 22, respectively, claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 are patentable for the same reasons as their respective independent claims set forth above, as well as for the additional elements they require.

Conclusion

In view of the above, Applicant respectfully requests favorable reconsideration and allowance of all pending claims. The Commissioner is hereby authorized to charge any fee deficiency in connection with this Amendment C and Response After RCE to Deposit Account Number 01-2384.

Respectfully Submitted,

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